

REMARKS

Reconsideration of this Application is respectfully requested. Applicant wishes to thank the Examiner for his kind consideration and helpful comments during the Interview conducted on August 3, 2007. Claims 3, 4, 6, 16-24 and 26 are amended, accordingly, without prejudice or disclaimer. Claims 1, 2, 5, 7-15 and 25 are cancelled, also without prejudice or disclaimer. Claims 3, 4, 6, 16-24 and 26 remain in this case.

Initially, the Examiner objected to the drawings under 37 C.F.R. § 1.83(a) on grounds that they must show every feature of the invention specified in the claims. The Examiner acknowledged Applicant's submission of new drawing FIGS. 7 and 8, though commenting that the drawing sheets, which were received by him electronically, are "blank".

* * * * *

As it is apparent that an error occurred upon electronic transmission/reception of the subject drawing Figures previously, Applicant has undertaken to provide, in hard copy, the two (2) additional sheets of formal drawings illustrating FIGS. 7 and 8, respectively, as submitted previously, each with a flow chart indicating steps of the claimed method. In this regard, Applicant respectfully notes the Examiner's indication, in the previous Office Action, that the steps of the claimed method can readily be shown by way of such a flow chart.

We respectfully submit that such drawing sheets are added to this Application, without prejudice or disclaimer. No new matter has been added.

Withdrawal of the Examiner's objection is, therefore, respectfully requested.

* * * * *

AMENDMENTS TO THE DRAWINGS:

The attached two sheets of formal drawings include new FIGS. 7 and 8, respectively. These sheets are in addition to the original four (4) drawing sheets in the captioned Application illustrating FIGS. 1-6.

Attachments: New Drawing Sheets Five (5) and Six (6).

The Examiner then rejected claims 24-26 under 35 U.S.C. § 101 on grounds that the invention is directed to non-statutory subject matter. According to the Examiner, one of the subject matters Courts have found to be outside the four statutory categories of invention is abstract ideas. The Examiner refers Applicant, in this regard, to *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874), which purportedly held that “idea of itself is not patentable, but a new device by which it may be made practically useful is”); *Mackay Radio & Telegraph Co. v. Radio Corp. of America*, 306 U.S. 86, 94, 40 U.S.P.Q. 199, 202 (1939). The Examiner explains that the instant claims fail to recite any physical structure or a sequence of physical steps that can be performed.

* * * * *

Contrary to what is argued by the Examiner, we respectfully submit that the subject matter of Claims 24-26, as submitted previously, and of Claims 24 and 26, as presently amended, is directed to a method of playing an educational and therapeutic game which provides (i) articles, namely, a plurality of cards, each card having pictorial or textual data disposed thereon, and/or (ii) a device, i.e., a flexible wire, operable to be folded into shapes to represent a word, clause, phrase or a clue regarding the same, wherein at least one player chooses from the plurality of cards and then tries to shape and fold the flexible wire to represent the data, i.e., pictorial or textual, disposed on the card, and, thereby, undergoes physical and cognitive therapy.

Applicant respectfully disputes the Examiner’s contention that his claimed method is merely an “idea” and, thus, non-statutory subject matter. Indeed, we submit, Applicant’s method, as claimed, relates to steps performed on a device and/or using articles and other statutory subject matter.

It is respectfully noted by Applicant has, notwithstanding, amended Claims 24 and 26, without prejudice or disclaimer, so as to positively recite the step(s) performed and, thereby, to better define the invention without limiting effect. Claim 25 is cancelled, without prejudice or disclaimer, we submit, rendering moot any issues taken by the Examiner in this regard.

Based on the foregoing, withdrawal of the Examiner's rejection under § 101 is appropriate.

* * * * *

Next, the Examiner rejected claims 1-11, 13, 14, 22 and 23 under 35 U.S.C. § 112, second paragraph, for indefiniteness. In particular, the Examiner takes the position that one cannot determine if claims 1-11 are directed to a method or an apparatus. The Examiner indicates that, since the remaining claims recite a method, they are being treated, for purposes of this Office Action, as intended to being drawn to an apparatus.

Also, the Examiner explains that claims 13, 14, 22 and 23 recite rules and fails to set forth any further physical steps to be performed in the process of the game and is held to be indefinite because it merely recites a use without any active, positive steps delimiting how this use is actually practiced. In this connection, the Examiner cites *Ex Parte Erlich*, 3 U.S.P.Q.2nd 1011 (Bd. Pat. App. & Inter. 1986).

The Examiner then asserts that while Applicant has amended Claims 1-11 to read "a game system", such, he says, does not overcome this rejection, commenting that a "system" can be a method or an apparatus.

As for Claims 13, 14, 22 and 24, the Examiner argues that "at best" these

recitations recite rules, that rules do not set forth positive action steps that one can perform that would further limit the claimed invention, and disagreed with Applicant's contention they recite "an optional step of the method of practicing the game".

* * * * *

Although Applicant respectfully disagrees with the Examiner's position in this regard, Claims 1, 2, 5 and 7-11 are cancelled and Claims 3, 4, 6 and 16-23 are amended to depend directly or indirectly from Claim 24, collectively, without prejudice or disclaimer. Claims 3, 4 and 6 are now directed to a "method" of treatment rather than a "game system".

Withdrawal of the Examiner's rejection under § 112 is requested.

* * * * *

Thereafter, the Examiner rejected claims 1-10, 12-15 and 18-26 under 35 U.S.C. § 103(a) as being obvious and, therefore, unpatentable over What is Claymania in view of Wire Sculpture. Specifically, with regard to claims 1-3, 5-10, 12, 15 and 20-25, the Examiner takes the position that What is Claymania shows making a sculpture conforming to indicia on cards out of clay within a given amount of time. He states that while the use of wire is not discussed, the prior art teaches that wire is a well-known media for making a sculpture. The Examiner explains that to have replaced the clay of What is Claymania with wire would have been an obvious matter of choosing one known media for that of another. He notes that Applicant has not shown his choice of media to be critical by solving any particular problem or producing any unexpected results.

With regard to claim 4, the Examiner asserts that providing individual color coded game paraphernalia to players is old and well-known. Similarly, says the Exami-

ner, having cards categorized to different levels of difficulty, as purportedly set forth in claims 7, 19 and 25, is known in question and answer games.

As for claims 13, 14, 22 and 23, the Examiner argues that these claims reflect only rules of play that are analogous to functional limitations in an apparatus claim in that they fail to further limit the claim by reciting a positive physical step that can be performed. As such recitation, he says, fails to distinguish over the art of record, attempts to claim a process without setting forth any steps involved in the process generally raises an issue of indefiniteness under 35 U.S.C. § 112, second paragraph, as set forth above.

The Examiner comments, in response to Applicant's argument that his game is entirely different from What is Claymania, that the ability to make shapes of both clay and wire are considered "fairly taught" in the art. Likewise, he says, the use, or not allowing the use, of body language in such a game (such as charades) is not something that was invented by Applicant and is "fairly taught" by the art as a whole.

* * * * *

Finally, the Examiner rejected claims 11, 16 and 17 under 35 U.S.C. § 103(a) as being obvious and, therefore, unpatentable over What is Claymania in view of Wire Sculpture in view of Cohen, U.S. Patent No. 5,120,066. More particularly, the Examiner reiterates that in What is Claymania, prevailing players are recorded as being awarded a token that marks a space. He then looks to Cohen which, the Examiner says, teaches that it is known in question and answer type games to have moves being awarded for correct answers to the cards and die and spinners are well-known equivalents with respect to random number generators. The Examiner concludes that, to have recorded

the prevailing game events of What is Claymania with a spinner that awarded advancement of a players playing piece would have been obvious in order to record game events of a player.

* * * * *

In response to the Office Action, Applicant respectfully states that Claims 1, 2, 5, 7-15 and 25 are cancelled without prejudice or disclaimer. In addition, Applicant has undertaken to amend Independent Claims 24 and 26 to clarify novel and non-obvious features of Applicant's invention, namely, his *method of treatment using an educational and therapeutic game*.

Support for Applicant's amendments may be found, for example, in the Specification, on page 3, lines 16-24; and from page 7, line 25 through page 8, line 30. Claims 3, 4, 6, 16-23, it is noted, are amended to depend directly, or indirectly, from Claim 24.

The method, which necessitates strength, dexterity and acuity to develop wire shapes so as to represent pictorial or textual data disposed on a card, or a clue regarding the same, *simultaneously provides (i) physical therapy and cognitive therapy to the at least one of the players forming the flexible wire, and (ii) cognitive therapy to at least one of the other players who guesses the pictorial or textual data disposed on the card, or a clue regarding the same.*

For the player forming the flexible wire, the physical therapy, for instance, strengthens muscles in the player's fingers, hands and wrists while enhancing the player's fine motor skills upon specific manipulation and actions unique to wire forming, whereas the cognitive therapy, for example, stimulates the player's logic and reasoning

skills as well as hand-to-eye coordination.

For the other player(s), the acuity necessary for such player(s) to guess what pictorial data, textual data or clue is represented concurrently provides cognitive therapy to such other player(s), stimulating the players' logic and reasoning skills as well as their memory recall.

* * * * *

Notwithstanding the foregoing, Applicant respectfully disagrees with the Examiner's application of the cited references.

First, we again respectfully submit that, in What is Claymania, a board game is described in which a player is given a selected period of time, i.e., 45 seconds, to sculpt a mound of clay into an object while his/her teammates try to guess what the player is making. The player is allowed to "animate" the clay, but may not say a word. The first team to collect five colored tokens wins. In addition to clay, the game utilizes 300 word cards, 10 colored game tokens, 2 team markers, a square game board, an hourglass timer, and a die. According to its makers, Claymania develops creative expression, imagination, abstract thought, quick thinking and acting skills, language and vocabulary, as well as hand-eye coordination.

This is entirely different from Applicant's invention which is a method of treatment wherein a player first decides what "word, phrase or clause" he/she wants to represent, and then shapes and/or folds a *flexible wire* into a shape that is either representative of the "word, phrase or clause" the player decided on, or of a "clue" which will aid his/her teammates in determining the word, phrase or clause the player has chosen. Specifically, the flexible wire may be folded into the actual shape of the word,

or a shape representative of the word. The player may also use body movement as a tool in communicating the identity of the word, phrase or clause or clue regarding the same. In addition to a flexible wire, the game provides a game board, a timer and a spinner. Points are awarded based upon the complexity of the word, phrase or the like. Unlike the stated objectives of What is Claymania, Applicant's invention is used for physical and cognitive therapy. Further, we respectfully note that Applicant, of course, does not contend that he has invented the use, or not allowing the use, of body language, but rather that, as claimed, these features are among many steps of, and to be combined with, the method of treatment now claimed by Applicant.

Second, we maintain that the Examiner's application of Wire Sculpture, which is an art form of creating works of art from wire, to Applicant's board game for entertainment, education and/or therapeutics, and his accompanying argument that such a combination would have been obvious to one having ordinary skill in the art is tantamount to a hindsight reconstruction. More specifically, the Examiner has concluded that Applicant's invention is obvious, not by applying one reference that necessarily suggests application of features in another, but rather by picking and choosing components and steps from separate and distinct inventions, albeit in unrelated fields, in order to arrive at Applicant's invention.

Moreover, even if it were obvious to combine What is Claymania with Wire Sculpture, we submit, the result would not show all of the features of Applicant's invention, as claimed. For example, the result would require colored game tokens which are not utilized by Applicant's game, and would be devoid of the "flexible wire" used by Applicant which is easily shaped and folded, e.g., bent, by a player's hands; unlike the

hard or stiff wires that require welding and metal working tools as are used by artists to create a wire sculpture.

Similarly, Cohen, while relating to a board game, does not disclose or suggest Applicant's integration of a board game with wire shaping and folding, whether for education and/or therapeutics.

* * * * *

Given the foregoing differences, it is respectfully submitted that Applicant's invention is entirely different from that set forth by any of the references.

Indeed, we respectfully submit that none of the cited references, whether taken alone or in any combination, disclose or suggest Applicant's invention, as claimed. Withdrawal of the Examiner's rejections under § 103(a) is respectfully requested.

Applicant has made a good faith attempt to place this Application in condition for allowance. Favorable action is requested. If there is any further point requiring attention prior to allowance, the Examiner is asked to contact Applicant's counsel at (646) 265-1468.

Respectfully submitted,



Andres N. Madrid, Esq.
Registration No. 40,710
POLLACK, P.C.
The Chrysler Building
132 East 43rd Street, Suite 760
New York, New York 10017
Telephone: (646) 265-1468
Facsimile: (646) 253-1276
E-mail: amadrid@pollackpc.com

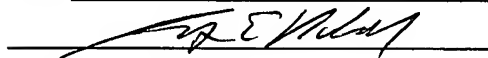
Attorney for Applicant

Dated: November 26, 2007

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail, in an envelope with sufficient postage addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

on November 26, 2007

Name Grant E. Pollack


Signature

APPENDIX